

JUL. 30. 2007 4:44PM

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ATTORNEY DOCKET NO. 03-LJ-011 (STM101-03011)  
U.S. SERIAL NO. 10/604,964  
PATENT

REMARKS

Claims 1-3 and 20-36 are pending in the application.

Claims 20-32 and 34-36 have been purportedly withdrawn from consideration.

Claims 1-3 and 33 have been rejected.

No Claims have been amended, and reconsideration is respectfully requested.

I. DECLARATION OF PRIOR INVENTION

The Office Action asserts that the previously submitted Declaration of Prior Invention Under 37 CFR 1.131 is ineffective to overcome the cited reference. This determination is respectfully traversed.

The Office Action requests submission of pages 24-26 from the notebook number 1988 (identified in invention disclosure form submitted with the Declaration). In compliance, Applicant is submitting herewith copies of the pages 24-26.

Applicant has now complied with all outstanding requirements with respect to the Declaration (which include the attached exhibits and documents submitted herewith), and the Declaration establishes prior invention over the cited reference.

II. REJECTION UNDER 35 U.S.C. § 102

Claims 1-3 and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by Abdollahi ("Leakage Current Reduction in Sequential Circuits by Modifying the Scan Chains", Fourth Symposium, 24-28 March 2003). The rejection is respectfully traversed.

Page 10 of 13

JUL. 30. 2007 4:44PM

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NO. 0867 P. 13

JUL 30 2007

ATTORNEY DOCKET NO. 03-LJ-011 (STMI01-03011)  
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As set forth above, the Declaration establishes Applicant's prior invention to the Abollahi reference. Therefore, Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claims 1-3 and 33.

III. ELECTION/RESTRICTION REQUIREMENT

Claims 20-32 and 34-36 are subject to an election/restriction requirement as being directed to an invention that is independent or distinct from the invention as originally claimed. This election/requirement is respectfully traversed.

The Office Action argues, without explanation, that Claims 20-32 and 34-36 recite an invention(s) that is independent or distinct from the invention as originally claimed. The Office Action's argues that "[s]ince application has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits." Office Action, page 3. This statement is irrelevant and cannot form the basis of an election/restriction requirement. The proper basis for an election/restriction requirement is correctly stated in the Office Action - the invention claimed must be independent or distinct from the other claimed inventions. The Office Action has failed to establish (or provide any reasoning from which a person could conclude) that the subject matter recited in Claims 20-32 and 34-36 is an invention that is "independent" or "distinct" from that originally described in Claims 1-3 and 33. Thus, this restriction requirement is not well-taken.

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Claims 20-22 depend directly or indirectly from original Claim 1. The Office Action fails to explain or address how a dependent claim recites an invention that is different or distinct from the invention claimed in the independent claim from which it depends.

With respect to independent Claims 23 and 32, the subject matter recited therein is similar to the subject matter of original Claim 1. For example, original Claim 1 recites (generally) five main elements: (1) circuit elements; (2) scan chain elements; (3) a vector memory; (4) a multiplexer, and (5) a clock generator. Similarly, independent Claims 23 and 32 (means) also recite five similar main elements: (1) circuit elements; (2) scan chain elements; (3) a vector memory (or means for storing); (4) a multiplexer (or means for selecting), and (5) a clock generator (or means for generating). Though independent Claims 23 and 32 further recite a test vector and two multiplexers (or two means for selecting), it is clear that the subject matter is similar to Claim 1. The mere addition of elements/features that narrow the claim language or that use similar claim language, without more, is an insufficient basis to assert the invention is independent or distinct from the original claimed invention.

With respect to Claims 34-36, these claims recite a method that is similar to the apparatus claims 23-32. Thus, the same reasoning set forth above applies to these claims.

The Office Action has failed to establish a *prima facie* case that the invention(s) claimed in Claims 20-32 and 34-36 are independent or distinct from the invention(s) claimed in claims 1-3 and 33. Accordingly, the Applicant respectfully requests withdrawal of the election/restriction requirement.

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CENTRAL FAX CENTER NO. 0867 P. 15

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IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at [wmunck@munckbutrus.com](mailto:wmunck@munckbutrus.com).

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

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